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| EXAMINER STERRETT, JONATHAN G | | | | |
| ART UNIT 3623 | | PAPER NUMBER | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspto@ti.com

Office Action Summary

Application No.

10/635,105

Applicant(s)

CUI ET AL.

Examiner

JONATHAN G. STERRETT

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 6-4-08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a **Final Office Action** upon examination of application number 10/635,105. **Claims 1-20** are pending. The examiner notes that new grounds of rejection are given below for 35 USC 101 and 103(a). Thus the arguments given previously are moot.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1 is rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Thus, **Claim 1** is non-statutory. **Claims 2-5** depend on Claim 1 and are not statutory at least for the reasons given for **Claim 1**.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Pellegrino US 6,149,441 (hereinafter **Pellegrino**)

Regarding **Claims 1-20**, Pellegrino teaches a system and a method for providing a way for teachers to build lesson plans, where those lesson plans include links to various other media for the purpose of giving students additional material (e.g. files, html pages, multimedia documents) to use in their learning experience. Pellegrino teaches various embodiments as part of the lesson planning and executing invention, however, Pellegrino's invention showed that these various embodiments illustrate that the limitations of the claimed invention, at least separately, were known in the art. Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the various teachings and embodiments of Pellegrino, regarding a computer based system of providing lesson planning, because it would have provided a predictable result in providing for a computer based way to enhance the learning environment of students.

Regarding **Claim 1**, Pellegrino teaches:

1. A time management method, comprising:

coupling at least one portion of a file to a task in a task management application, wherein the at least one portion of the file relates to the task to which it is coupled to.

Column 2 line 45-55, lesson plan material is stored, where the lesson plan material including files, is coupled to the specific lessons (i.e. tasks). See also column 11 line 30-35; column 22 line 4-10

Regarding **Claim 2**, Pellegrino teaches:

2. The time management method of claim 1, wherein the task management application is utilized by at least one of a student or a teacher to track assignments due.

Column 3 line 46-47; column 10 line 40-43, teachers use the application to track various assignments that are due; see also column 18 line 49-53; column 20 line 65-67

Regarding **Claim 3**, Pellegrino teaches:

3. (currently amended) The time management method of claim 1 wherein the coupling step includes at least one of linking the task to at least one appointment in a data base to maintain a relationship between the task or to allow a user to at least one of create remove or edit the relationship.

column 10 line 55-60, the user can link to pages based on the lesson plan and edit the linked pages (i.e. change the relationship between the lesson and the particular file the lesson is linked to). See also column 13 line 33-43.

Regarding **Claim 4**, Pellegrino teaches:

4. (currently amended) The article time management method of claim 3 wherein the task is in an assignment due list of a calendar of the time management application.

Column 10 line 48-49; a series of lessons (i.e. including assignments with the lesson plan) (re; Webster's 10th Edition Collegiate Dictionary – Calendar defined as “an orderly list”).

Regarding **Claim 5**, Pellegrino teaches:

5. (currently amended) The time management method of claim 4 wherein time periods relate to the task in the calendar of the time management application, wherein the time periods are class periods.

Column 26 line 44-50, the lessons are for class sessions (i.e. periods).

Claims 6-20 recite similar limitations to those addressed by the rejection of Claims 1-5 above, and are therefore rejected under the same rationale.

Furthermore Regarding Claims 6-20, Pellegrino teaches a computer system and software for performing the method steps (see Figure 1).

Furthermore regarding Claim 19, Pellegrino teaches a computer system with a server and a computer that links to the server to perform the method steps. Pellegrino does not explicitly teach a portable computer system, however Official Notice is taken that portable computers (i.e. laptops or PDA's) are known in the art to provide mobile computing. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Pellegrino to include using a portable

computer, because it would have provided a predictable result through providing a user of the system and method with a way to do so with a computer that was portable

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

WO/007757 A2 by Riley teaches a family management system.

Benjamin, et.al "Project Plan Document", last updated 31 October 2001, pp.1-3
retrieved from the web at
http://people.clarkson.edu/~jnm/cs450.archive/cs450.fa2001/proj/pOrganizer/POrganizer/docs/Project_Plan_Document/ProjectPlanDocument.htm

This document notes a Clarkson university class project to incorporate many of the claimed aspects into a PDA (Palm (TM)) application. The examiner would respectfully point out the date to the applicant and the fact that college students are working on a project to design and build a PDA with many of the claimed limitations.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan G Sterrett whose telephone number is 571-272-6881. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on 571-272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

1-8-09

JGS

/Jonathan G. Sterrett/
Primary Examiner, Art Unit 3623